REMARKS

In view of the following remarks and the foregoing amendments, reconsideration and allowance are respectfully requested.

Claims 2, 8, 10, 19-21, 23, 25 and 36 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over D'Arlach et al. (US Patent No. 6,026,433) ("D'Arlach") in view of Kobayakawa et al. (US Patent No. 6,119,078) ("Kobayakawa"). Claims 5, 22, 33, 34 and 37-39 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over D'Arlach and Kobayakawa in further view of Evans, III (US Patent No. 5,732,231) ("Evans"). Claim 30 stands rejected under 35 U.S.C. 102(a) as allegedly being unpatentable over D'Arlach in view of Kobayakawa further in view of Evans. Claim 24 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over D'Arlach and Kobayakawa further in view of Dan et al. (US Patent No. 6,560,639) ("Dan"). The foregoing contentions are respectfully traversed.

Although Applicant maintains that claim 19-23 were patentable as written, claims 19-23 are cancelled without prejudice to expedite prosecution of the present invention.

Claims 8, 24, 25, 30 and 36 are currently amended. No new matter has been added. (*See, e.g.*, specification, page 17, lines 21-22; page 20, lines 2-5, 13-23; page 21, lines 1-2, 3-6, 17-18). Therefore, claims 2, 5, 8, 10, 24-25, 30, 33, 34, 36-39 are now pending, with claims 8, 19, 30, and 36 being independent.

Applicant graciously thanks the Examiner for the interview granted to Applicant's representatives. The pending rejections in this matter were discussed, but no formal agreement was reached.

35 U.S.C. 103 Rejections

All Pending Claims

All pending claims (claims 2, 5, 8, 10, 24-25, 30, 33, 34, 36-39) are allowable at least because (a) D'Arlach and Kobayakawa; (b) D'Arlach, Kobayakawa, and Evans; and (c) D'Arlach, Kobayakawa, and Dan, alone or in combination, do not teach or suggest each and every feature of the claims as recited in the claims.

D'Arlach and Kobayakawa (which forms the basis, at least in part, of every rejection) do not teach or suggest at least the feature of "dynamically" generating a web document or generating a web document in "real time" as recited in the claims.

Response to Arguments

(a) Kobayakawa

The Office Action states that Kobayakawa, in column 3, lines 32-37, shows the translation and dynamic generation of one web page to another. Applicant respectfully disagrees. Kobayakawa at column 3, lines 32-37 states:

> Accordingly, when a URL or partial URL is located in the database that is similar to the transmitted URL, the translating environment associated therewith is selected. The Web page transmitted to the client from the server is then translated from the first language to the second language using the selected translation environment. For example, a Web page in Japanese can be translated into English, or vice versa.

Thus, as shown above, Kobayakawa only shows translating a static web page in a first language by inputting the URL (Uniform Resource Locator) of that web page. (*See, e.g.*, Kobayakawa: Abstract, Summary, Col. 3, lines 19-31). In Kobayakawa, a web page is not "dynamically" generated or created, the web page is simply translated using that web page's URL.

Conversely, in the claimed inventions (such as in claim 8), a user web document is dynamically (e.g., in real time) generated in a second spoken language using desired user variables from a prearranged document or form web document in a first spoken language. Unlike Kobayakawa, in the claimed invention, the web page in a first spoken language does not even have to exist. Whereas conversely, Kobayakawa requires that a web page that is to be translated previously exists, with its own URL.

Because the cited references fail to teach or suggest at least this feature, the cited references fail to teach or suggest each and every feature of the claims. For at least this reason, the 35 U.S.C. 103 rejections are improper and should be respectfully withdrawn.

(b) Suggestion to Combine

The Office Action further states that in response to Applicant's argument that there is no suggestion to combine the references, that "[i]n this case, the knowledge is generally available to one of ordinary skill in the art." [Office Action, at 13.] Applicant respectfully disagrees that such a rejection is proper.

The "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (MPEP 2143; *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Furthermore, "the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness" (MPEP 2143). Accordingly, the statement that the "knowledge is generally available to one of ordinary skill in the art" fails to sufficiently demonstrate motivation to combine the references at issue, and therefore, the rejection should be withdrawn.

Accordingly, for at least this independent reason, the 35 U.S.C. 103 rejections are improper and should be respectfully withdrawn.

(c) Dependent Claims

The pending dependent claims are also patentable for each depends on an allowable base claim, and for reciting patentable subject matter in their own right. Allowance of these dependent claims is respectfully requested.

For at least these reasons, the Applicants respectfully request withdrawal of the 35 U.S.C. 103 rejections to all the pending claims, and ask that those claims be placed in condition for allowance.

Conclusion

At least in view of the amendments and remarks herein, the Applicants believe that Claims 2, 5, 8, 10, 24-25, 30, 33, 34, 36-39 are in condition for allowance and ask that these pending claims be allowed. It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific issue or comment does not signify agreement with or concession of that issue or comment. In addition, because the arguments made above may not

be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

All of the pending claims are now in condition for allowance. A formal notice to that effect is respectfully solicited. Applicant respectfully requests that all claims be allowed. Enclosed with this Amendment is a Request for Continued Examination. The Commissioner is hereby authorized to charge any fees or credits to Deposit Account 02-4553.

Respectfully submitted,

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